REMARKS

Claims 19-26 and 32-33 are currently pending in the present application, of which claims 19 and 32 are independent. Claims 1-11 and 19 have been cancelled and claims 12-18, 28-31, and 34-36 have been withdrawn without prejudice. Claims 19, 20, and 32 have been amended. No new matter has been added. Claims 19-27 and 32-33 have been rejected.

35 U.S.C. §103(a)

Claims 19-20, 23-27, and 32-33 have been rejected under 35 U.S.C. §103(a) as being obvious over Barwick, et al. (U.S. Patent No. 5,700,240) (hereinafter, "Barwick") in view of Murry, et al (U.S. Patent No. 4,156,187) (hereinafter, "Murray") or WO9207622. Applicant respectfully traverses this rejection for at least the following reasons.

35 U.S.C. §103(a) sets forth in part:

> [a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said matter pertains.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP §2142; Verlander v. Garner, 248 F.3d 1359, 1363 (Fed. Cir. 2003).

The currently pending claims are not rendered obvious in light of Barwick in view of Murray and/or WO9207622.

Barwick fails to teach or suggest each and every element of the pending claims and Murray and/or WO9207622 fail to make up for the deficiencies. Barwick fails to teach or suggest (1) a matrix comprising phaco power levels and fluid flow conditions that will not generate sufficient heat to create damage to eye tissue within the eye, wherein the system is configured to control at least one of the phaco power or fluid flow based upon an amount of thermal energy delivered to the eye over a predetermined period of time; and (2) providing a matrix comprising power levels, power duty cycles, and fluid flows that will not generate sufficient heat to create a burn of eye tissue; and

controlling at least one of the phaco power or fluid flow based upon an amount of thermal energy delivered to the eye over a predetermined period of time.

Barwick does not teach or suggest these elements of the independent claims. In fact, Barwick is silent as to a matrix, the correlations, or a system configured to control the phaco power or fluid flow based upon an amount of thermal energy deliverd over a predetermined period of time as claimed, as well as not generating sufficient heat to damage eye tissue. Barwick is silent about heat due to the fact that it pertains to managing post occlusion surge. In the Summary of the Invention, Barwick describes the various features of the invention and managing the aspiration rate based upon the occlusion and how a surgeon may increase or decrease the aspiration rate based upon their preference. Barwick states, in pertinent part, "[o]n the other hand, again depending upon the occluding material, the physician may wish to reduce the aspiration rate, for example, to *maintain stability of the eye* during removal of the occluded material." Col. 3, lines 9-12 (emphasis added). The Examiner assumes Barwick is adjusting the aspiration rate for heat dissipation despite the fact that Barwick is silent on this point and explicitly discusses adjusting aspiration for chamber stability. It is only through impermissible hindsight that the present invention becomes obvious.

With respect to dependent claim 26, Barwick fails to teach or suggest "the system is configured to adjust a phaco power level based upon irrigation fluid flow conditions." The Examiner asserts this element is disclosed in column 4, line 22, however there is no pump associated with the irrigation line (see Fig. 1) and as such, the control unit does not adjust a phaco power level based on the irrigation fluid flow conditions.

Based upon the foregoing, Barwick fails to teach or suggest, *inter alia*, a (1) a matrix comprising phaco power levels and fluid flow conditions or power level, power duty cycles, and fluid flows that will not generate sufficient heat to create damage to eye tissue within the eye, where the system is configured to control at least one of the phaco power or fluid flow based upon an amount of thermal energy delivered to the eye over a predetermined period of time; and (2) the system is configured to adjust a phaco power level based upon irrigation fluid flow conditions; and Murray and WO 9207622 fail to make up for the deficiencies of Barwick.

Neither Murray nor WO 9207622 teach or suggest a (1) a matrix comprising phaco power levels and fluid flow conditions that will not generate sufficient heat to create damage to eye tissue within the eye, wherein the system is configured to control at least one of the phaco power or fluid flow based upon an amount of thermal energy delivered to the eye over a predetermined period of time; or (2) providing a matrix comprising power levels, power duty cycles, and fluid flows that will not generate sufficient heat to create a burn of eye tissue; and controlling at least one of the phaco power or fluid flow based upon an amount of thermal energy delivered to the eye over a predetermined period of time. Murray and WO 9207622 also fail to teach or suggest the system is configured to adjust a phaco power level based upon irrigation fluid flow conditions.

Based upon the totality of the foregoing, Applicant respectfully submits that claims 19 and 32, are allowable over the references of record, as well as the claims that depend therefrom.

35 U.S.C. §103(a)

Claims 21 and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Barwick in view of Murry or WO 9207622 as claims 19-20, 23-27, and 32-33, and further in view of Costin (U.S. Patent No. 5,733,256) (hereinafter, "Costin") or Lo, et al. (U.S. Patent No. 4,954,960) (hereinafter, "Lo"). Applicant respectfully traverses this rejection for at least the following reasons.

35 U.S.C. §103(a) sets forth in part:

> [a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said matter pertains.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP §2142; Verlander v. Garner, 248 F.3d 1359, 1363 (Fed. Cir. 2003).

The Examiner has failed to establish a *prima facie* case of obviousness and the currently pending claims are not rendered obvious in light of Barwick in view of Murry, and/or WO 9207622 and further in view of Costin and/or Lo.

As discussed above, Barwick fails to teach or suggest (1) a matrix comprising phaco power levels and fluid flow conditions that will not generate sufficient heat to create damage to eye tissue within the eye, wherein the system is configured to control at least one of the phaco power or fluid flow based upon an amount of thermal energy delivered to the eye over a predetermined period of time; and (2) providing a matrix comprising power levels, power duty cycles, and fluid flows that will not generate sufficient heat to create a burn of eye tissue; and controlling at least one of the phaco power or fluid flow based upon an amount of thermal energy delivered to the eye over a predetermined period of time. The Examiner cites Costin and Lo for teaching a flow sensor or a temperature sensor, which he acquiesces is not taught in Barwick. However, even assuming *arguendo* that those elements are taught by Costin and Lo, the references fail to make up for the deficiency of Barwick, Murry, and WO 9207622.

Thus, the cited references individually and in combination, fail to teach or suggest each and every element of the claimed invention and thus, fail to render the presently claimed invention obvious.

Based upon the totality of the foregoing, Applicant respectfully submits that claims 19 and 32, are allowable over the references of record, as well as the claims that depend therefrom.

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.

CONCLUSION

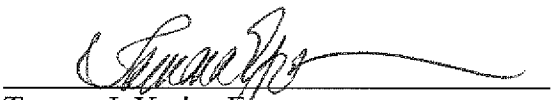
It is respectfully submitted that all claims of the present application are in condition for allowance. Consideration and allowance of all pending claims at an early date is respectfully requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Should any additional fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account No. 502317. Should the Examiner have any questions or concerns, please do not hesitate to contact the undersigning attorney at 714-247-8422.

Respectfully submitted,

Date: October 8, 2010



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